

**REMARKS**

Claims 1-36, 49, 51-63 and 65 are pending in the application. Claims 19-36, 56, 57, 61 and 65 have been cancelled. Dependent claims 68-71 have been added. No new matter has been added. Fewer claims have been added than have been cancelled. Entry of the foregoing amendments is therefore respectfully requested.

I. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-36, 49, 51, 52, 55-57, 59-61, and 65 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Examiner states that the scope of “aryl” is unclear. Applicant respectfully disagrees for at least those reasons of record. Nonetheless, to expedite prosecution, Applicants have removed this term from the claims.

The objection to claim 19 and various dependent claims as substantial duplicates is now moot because these claims have been cancelled.

II. Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-36, 49, 51-62 and 65 have been rejected under 35 U.S.C. §112, first paragraph, as non-enabled. The Examiner states that the scope of the R variables entails more than what is disclosed in the '828 patent, which is incorporated by reference in the pending application. Specifically, the Examiner queries how all of the recited piperazine precursors “can possibly be used to make mirtazapine and other piperazinoazepines.”

Applicants respectfully submit that, in view of the specification, one of ordinary skill in the art would know how to use the claimed compounds, as currently amended, to prepare mirtazapine, other piperazinoazepines, or intermediates thereof. “How to use” the claimed methods is inherent in the steps of each method; each step would be understood by one of ordinary skill in the art.

III. Rejections Under 35 U.S.C. § 103(a)

Claims 49 and 58-62 have been rejected under 35 U.S.C. §103(a) as obvious over Lafon. The Examiner states that it would have been obvious to replace the H on the piperazino carbon

with a methyl group. Claim 49, however, as currently amended, does not include a methyl group within the scope of R1. Therefore, Applicants respectfully request withdrawal of this rejection.

IV. Rejections Under 35 U.S.C. § 102(b)

Claims 2, 4-10, 20, and 22-28 have been rejected under 35 U.S.C. §102(b) as being anticipated by Olivie '452. All of these claims have either been amended to remove the recitation of "aryl" or have been cancelled. Thus, Olivie '452 does not disclose any compound within the scope of the claims as currently amended.

*New issues considered*  
Claims 49 and 58-60 have been rejected under 35 U.S.C. §102(b) as being anticipated by Toda '190. Toda, however, does not disclose any compound within the scope of the claims as currently amended.

Claims 1, 2, 4-7, 10, 19, 20, 22-25, 28, 49, 51, 52, 54, and 56-62 have been rejected under 35 U.S.C. §102(b) as being anticipated by Nitta '548. And claims 8, 9, 11-13, 26, 27, and 29-31 have been rejected under 35 U.S.C. §103(a) as obvious over Nitta in view of Olivie and Winkley. Nitta, however, does not disclose any compound within the scope of the claims as currently amended. Neither Olivie nor Winkley remedy the deficiencies of Nitta.

Claims 49 and 58-60 have been rejected under 35 U.S.C. §102(b) as being anticipated by Nishimura. Nishimura, however, does not disclose any compound within the scope of the claims as currently amended.

V. Rejections For Obviousness-Type Double Patenting

*OK*  
Claims 1-36, 49, 51-63 and 65 have been rejected for obviousness-type double patenting over the claims of U.S. Patent No. 6,339,156. Applicants have filed herewith a terminal disclaimer, thereby obviating this rejection.

CONCLUSION

Entry of the foregoing amendments is respectfully requested. In view of the foregoing amendments and remarks, an early and favorable action on the merits is earnestly solicited. The Examiner is invited to contact the undersigned attorney if such communication is believed to be


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helpful in advancing the examination of the present application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 11-0600.

Respectfully submitted,  
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